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10/035,172

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Charles E. Hunter

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2421

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/035,172	<b>Applicant(s)</b> HUNTER ET AL.	
	<b>Examiner</b> Hoang-Vu A. Nguyen-Ba	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/16/02, 10/4/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the amendment filed October 28, 2008.
2. Claims 19-28 are pending. Claim 19 is an independent claim.

### ***Response to Amendments***

3. Per Applicants' request, Claims 1-18 and 29-32 are withdrawn from consideration; Claims 19 and 23 have been amended.
4. The objection to the drawings is withdrawn in view of Applicants amendments to Figure 3 to correct an identified typographical error.
5. The objection to the specification is withdrawn in view of Applicants' amendments to the specification to correct identified informalities.
6. The objection to Claim 23 is withdrawn in view of Applicants' amendments to the claim to improve the clarity of the claim language.

### ***Response to Arguments***

7. Applicants' arguments that the Logan reference of record is not prior art is persuasive and therefore the rejection of Claims 19-21 and 24-27 under 35 U.S.C. § 102(e) as being anticipated by Logan is withdrawn.

### ***Claim Rejections – 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or foreign country, before the invention thereof by the applicant for patent.

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9. Claims 19-20 and 24-27 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,177,931 to Alexander et al. (“Alexander”).

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

### **Claim 19**

Alexander discloses *a method for displaying advertisements at a user location, comprising:*

*determining a customer preference (see at least 6:52-55; 28:11-30:44);*

*displaying entertainment content at the user location, the entertainment content including insertion points for display of advertisements (see at least 6:56-59; 32:22-34:25);*

*receiving a plurality of advertisements at the user location (see at least 8:29-30; 8:41-43; 33:44-46; 34:11-12);*

*selecting a subset of the transmitted advertisements based upon the customer preference (see at least 34:2-35:37); and*

*displaying at least one of the selected advertisements during at least one of the insertion points (see at least 22:20-23:11; 24:40).*

### **Claim 20**

The rejection of base claim is incorporated. Alexander further discloses

*distributing a pre-recorded medium containing the entertainment content (see at least 33:44-46; 34:11-12) and*

*storing the medium at the user location (see at least 33:44-46; 34:11-12).*

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**Claim 24**

The rejection of base claim 19 is incorporated. Alexander further discloses *selecting a subset of the transmitted advertisements at the user location based upon the customer preference* (see at least 34:2-35:19).

**Claim 25**

The rejections of the base claim 19 and intervening claim 24 are incorporated. Alexander further discloses *selecting at least one of the cached advertisements based upon the customer preference* (see at least 4:36-38; 22:1-18; 24:9-20; 27:49-28:9; 33:44-46; 34:11-12), *and displaying the selected cached advertisements during the insertion points at the user location* (see at least 22:1-18; 24:9-20; 27:49-28:9).

**Claim 26**

The rejection of base claim 19 is incorporated. Alexander further discloses *receiving the entertainment content from a source remote from the user location* (see at least 8:18-64).

**Claim 27**

The rejection of base claim 19 is incorporated. Alexander further discloses *wherein: selecting a subset of the transmitted advertisements based upon the customer preference comprises selecting a transmitted advertisement based on the customer preference at a plurality of user locations in accordance with a purchase transaction by an advertiser* (see at least 34:2-35:37).

***Claim Rejections – 35 USC § 103***

10. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 by Alexander.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

### **Claim 21**

The rejections of the base claim 19 and intervening claim 20 are incorporated. Alexander does not specifically disclose *recording entertainment content on a medium having a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature.*

However, official notice is taken that the feature claimed is well known in the art as circuit (e.g., V-chip) designed to selective blocking audio and video signals for the purpose of preventing the receiver to display of record video or movies containing violence or nudity (see U.S. Patent No. 5,828,402 or 4,554,584, or 5,387,942).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate this well known in the art circuit in Alexander for the purpose discussed above.

### **Claim 22**

The rejections of the base claim 19 and intervening claims 20-21 are incorporated. Alexander does not specifically disclose *wherein: the medium comprises a disk having a diameter greater than about 125 mm and less than 300 mm.*

However, official notice is taken that disc that has a diameter greater than 125 mm (i.e., 12.5 cm) and less than 300 mm (i.e., 30 cm) is the well-known laser disc that is defined as follows by Whatis.com ([http://whatis.techtarget.com/definition/0,,sid9\\_gci212454,00.html](http://whatis.techtarget.com/definition/0,,sid9_gci212454,00.html)):

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### **laserdisc**

Laserdisc is a technology and the physical medium used in storing and providing programmed access to a large database of text, pictures, and other objects, including motion video and full multimedia presentations.

The laserdisc itself is 12 inches in diameter and holds much more information than a CD-ROM disk can currently hold. Laserdiscs require relatively expensive players and are more expensive to distribute than CD-ROM disks. However, for school and corporate education purposes and any presentation requiring a great deal of motion video and the ability to create scripted or programmed access to selected portions of the laserdisc, the technology can be useful.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use disc which has a diameter (12 in or 28.48 cm) similar to that of a laser disc to store Alexander's broadcast and ads contents because such a disc would allow more information to be stored.

It is noted that Applicant's specification indicates that "discs **may** provide a hardware security feature by incorporating a larger diameter than conventional CD or DVD" (emphasis added by examiner). The use of "may" is interpreted that the use of disc size (e.g., larger than 12 cm) is optional and will not be considered a distinguishable feature over the prior art (i.e., 12 cm) because the feature is optional and is not described in details in the specification how large is the diameter of the disk (e.g., a specific size range) and which type of player can read this type of disc. Without further details of the disc size and which existing player on the market that can play the disc of the disclosed size, the feature is considered to be non-enabling.

12. Claims 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 by Alexander in view of High Density Digital Videodisc Using 635 nm Laser Diode by Tsuchiya et al. ("Tsuchiya").

### **Claim 23**

The rejections of the base claim 19 and intervening claims 20-21 are incorporated. Alexander does not specifically disclose *wherein: the medium comprises a disk having data recorded on a reflective layer and an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification.*

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In an analogous art, Tsuchiya discloses a high density digital videodisc using 635 nm laser diode for the purpose of producing a high quality digital videodisc (see at least Abstract and Conclusions).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Tsuchiya in combination with that of Alexander because the combination would allow more content to be stored on a high quality medium such as that taught in Tsuchiya.

Since the claim language is unclear as to which DVD Specification is being referred to and as to the meaning of “an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification,” a coating that would reflect a 635 nm laser such as the one taught in Tsuchiya is used as a basis for the rejection of Claim 23 for compact prosecution purposes. Furthermore, since Applicant’s disclosure does not specifically provide sufficient support for the claimed feature, Applicant is requested to provide the mentioned standard DVD specification and to point out where in the DVD specification is set forth the minimum transmission and how this feature is related to that of the 635 nm laser.

13. Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 by Alexander in view of U.S. Patent No. 5,835,896 to Fisher et al. (“Fisher”).

#### **Claim 28**

The rejection of base claim 19 is incorporated. Alexander further discloses *wherein: selecting a subset of the transmitted advertisements based upon the customer preference comprises selecting a transmitted advertisement based on the customer preference at a plurality of user locations* (see at least (see at least 34:2-35:37).

Alexander does not specifically disclose that the selection is *in accordance with a winning bid of an advertiser in an auction*.

However, Fisher discloses a method for allowing a group of bidders to interactively place bids over a communications network, automatically recording the bids, updating the bidders



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with the current auction bid status information, closing the bidding process and notifying the winning bidder as to the auction outcome without using a human auctioneer (6:6-13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Fisher in Alexander as the use of Fishers technique would help advertisers to place bids for their advertisements and to know the outcome of the auction quickly for effective planning purposes.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

January 19, 2009